

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte** RON MCCABE, ROBERT CHURCH, TRACY CAMP,  
STUART W. CARD and DAVID J. SCHROEDER

Appeal No. 2005-2152  
Application No. 09/438,184

ON BRIEF



Before BARRETT, LEVY, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 6 and 27-45.<sup>1</sup>

Claims 1-5, 7-26, and 46-109 have been cancelled.

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<sup>1</sup>Appellants have not properly amended claim 6 to include the subject matter of claim 1. However, for purposes of our decision on the rejection under 35 U.S.C. § 103 only, we will treat claim 6 as though it properly includes all the subject matter of claim 1.

*Invention*

Appellants' invention relates to a data mirroring system where for instance, the invention permits the use of various combinations of one or more external storage units and/or RAID units to hold mirrored data. In addition, the invention provides many-to-one data mirroring, including mirroring from local servers running the same or different operating systems and/or file systems at two or more geographically dispersed locations. The invention also provides one-to-many data mirroring, mirroring with or without a dedicated private telecommunications link, and mirroring with or without a server at the destination(s) to assist the remote mirroring unit(s). Spoofing, SCSI and other bus emulations, and other tools and techniques are used in various embodiments of the invention. Appellants' specification at page 5, lines 3-11.

Claim 27 is representative of the claimed invention and is reproduced as follows:

27. A data mirroring system which is characterized by at least a disk emulation flexible mirroring characteristic and a many-to-one multiplicity flexible mirroring characteristics, the system for mirroring data from primary network servers having nonvolatile data stores, over journey links, to a remote nonvolatile data storage area, wherein the system comprises:

a source including at least two primary network servers, each primary server being linked through a respective local link to a respective local mirroring unit for sending mirrored data from the primary server to the local mirroring unit, each of the local mirroring units having a spoof packet generator and a nonvolatile data buffer for mirrored data, the local link including a standard storage subsystem bus and the local mirroring unit emulating a disk subsystem in communications over that bus; and

a destination including a remote mirroring unit having a destination nonvolatile storage for mirrored data received from the local mirroring units over the journey links.

***References***

The references relied on by the Examiner are as follows:

Staheli et al. (Staheli) 5,537,533                      Jul. 16, 1996

"Double-Take; Meeting The New Requirement For Enterprise Data Protection;" NSI Software; 1997; pp. 1-16 (Double-Take).

"FrameRunner"; StorageTek; March 16, 1999; pp. 1-5 (FrameRunner).

***Rejections At Issue***

Claims 6 and 27-45 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Staheli, Double-Take, and FrameRunner.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.<sup>2</sup>

***OPINION***

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated infra, we reverse the Examiner's rejection of claims 6 and 27-45 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new ground of rejection of claims 6 and 27-45. The basis for this is set forth in detail below.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

***I. Rejection of Claims 6 and 27 Under 37 CFR § 41.50(b).***

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 6 and 27-45 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

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<sup>2</sup>Appellants filed an appeal brief on September 7, 2004. The

particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 6 depends from a cancelled claim. Therefore it is indefinite on its face.

Claim 6 recites the term "characteristics." It is unclear what applicants are attempting to recite. Is this a function? Is this a structure? Is this a means? We have reviewed the specification and find no guidance on this point. Further, after a review of the art, we find no use of this term in the context present in the claim. We also note that if claim 1 is incorporated into claim 6, the problem becomes so pervasive that it is not possible to determine if the claim is a method (functions) in a system or the system itself.

Claim 27 recites the term "characteristic" in the preamble and shares the same problem as discussed above with respect to claim 6.

Claims 28-45 incorporate the problem of claim 27 by dependency therefrom.

***II. Whether the Rejection of Claims 6 and 27-45 Under 35 U.S.C. § 103 is proper?***

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 or § 103 begins with

determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art.

Because the appealed claims fail to satisfy the definiteness requirements of the second paragraph of § 112, it reasonably follows that the examiner's rejections under § 103 cannot be reached at this time. To that end, the predecessor of our reviewing court has held that it is erroneous to analyze claims based on "speculation as to the meaning of the terms employed and assumptions" as to their scope. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

Consequently, in comparing the claimed subject matter with the applied art, it is apparent that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, we reverse, *pro forma*, the Examiner's § 103 rejections. *Id.*

It is noteworthy that is a procedural reversal rather than one based upon the merits of the 35 U.S.C. § 103 rejections.

However, we do note that the Examiner provides very little explanation in the rejection to support their positions. Merely quoting a claim feature and citing

columns and lines in the reference to teach that feature is effective only when the reference speaks for itself. We do not see that in the situation before us. Rather, the Examiner should explain his thinking by indicating what item in the cited columns and lines corresponds to the claimed feature and explaining why this is so. Further, we note that general motivational statements such as we find in the present appeal seldom serve to properly combine references. This is particularly disconcerting when other specific motivations exist, as is the case before us. We strongly suggest that the Examiner restructure the rejection under 35 U.S.C. § 103 should there be any further prosecution in the instant application.

***Conclusion***

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 6 and 27-45.

We have entered a new ground of rejection against claims 6 and 27-45 under 37 CFR § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a]

new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record . . .

**REVERSED; 37 CFR § 41.50(b)**

*Lee E. Barrett*  
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Administrative Patent Judge )  
 )  
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